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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/773,774

02/06/2004

Gunther Durhammer

283-4 CIP

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EXAMINER

KEMMERLE III, RUSSELL J

ART UNIT

PAPER NUMBER

1731

MAIL DATE

DELIVERY MODE

09/25/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/773,774

**Applicant(s)**

DURHAMMER, GUNTHER

**Examiner**

Russell J. Kemmerle

**Art Unit**

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Amended independent claims 1, 8, 11, 18 and 25 have added the limitation that the layers of cellulose derivative are applied to the paper over at least the entire length of a tobacco column of the cigarette. This limitation is not described in the specification in such a way as to reasonably convey to one skilled in the art what the inventor had possession of at the time of invention.

New claims 37-41 recite the limitation that the layers of cellulose derivative are applied to the paper over the entire length of the cigarette. This limitation is not described in the specification in such a way as to reasonably convey to one skilled in the art what the inventor had possession of at the time of invention.

Dependent claims 2-7, 9, 10, 12-17, 19-24 and 26-36 are rejected as being dependent on the rejected independent claims discussed above.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiore (US Patent 3,185,161) in view of Swan (US Patent 2,091,572) and Godfrey (US Patent 4,140,135).

Fiore teaches application of a layer of ethyl cellulose to tobacco wrappers containing a tobacco product (example 1, Col 2 lines 19-40), specifically where the wrapper is composed of one layer of paper (Col 1 lines 15-25). Fiore further discloses applying the protective material to both sides of the paper (Col 1 lines 40-50).

Fiore does not disclose the application of multiple coatings of the protective material to the paper with a gravure type process, or that the protective material is applied over the entire length of the tobacco column, or over the entire length of the cigarette.

Swan discloses the application multiple coatings on paper using a gravure type process (Fig. 1). Swan further shows applying multiple coatings to the same side of the paper (Fig 1).

Godfrey discloses a hydrophobic coating for use with a tobacco product, which both prevents sticking of the material to the users lips, but also has positive effects on the tobacco during storage compared to an untreated wrapper (Col 1 lines 38-42, Col 7 lines 53-62). Godfrey discloses that the coating be applied over the entire surface of

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the wrapper (i.e., "at least a portion", implying that more than a portion, the whole, is also contemplated) (Col 3 lines 5-6).

It would have been obvious to one of ordinary skill in the art to use the coating method of Swan (coating, drying, then coating again) in the invention of Fiore, because Swan's invention produces uniform coatings with minimal defects (page 2, Col 1 lines 25-50). It would have been further obvious to coat the entire wrapper as taught by Godfrey (either of the entire length of the tobacco column or the entire length of the cigarette) since Godfrey discloses a positive effect on the storage of cigarettes thus treated.

Further, because Fiore recognizes the use of ethyl cellulose as a result effective variable for the control of moisture resistance (Col 1 lines 20-35), and the control of permeability of paper through measurement of Coresta units is notoriously well known in the tobacco manufacturing industry (see, for example, US Patents 4,984,589; 4,998,543; 5,033,484; 5,052,412; 5,056,537; 5,058,608 and 5,060,674) it would have been obvious to optimize the amount of coating and the number of coats of ethyl cellulose to within desired ranges.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-41 have been considered but are moot in view of the new ground(s) of rejection necessitated by applicant's amendment.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell J. Kemmerle whose telephone number is 571-272-6509. The examiner can normally be reached on Monday through Friday, 8:30-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RJK/

  
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